

### **REMARKS**

This Amendment is responsive to the final Office Action identified above, and is further responsive in any other manner indicated below.

### **OFFICE ACTION ERROR**

Applicant respectfully notes the error in the Office Action Summary at Items 4 and 6 regarding the claim count 1-7, Applicant further notes that new Claims 8-11 have been treated within the body of the Detailed Action.

### **35 USC §119 PRIORITY - ACKNOWLEDGE REQUIRED**

In the first section "CROSS-REFERENCE TO RELATED APPLICATIONS" in the specification, Applicant has properly identified the parent Application No. 09/764,289, now US 6,774,750 B1, upon which domestic benefit is claimed in the present continuing application. Additionally, Applicant submitted a claim for priority under §119 for JP 2000-068598 filed 8 March 2000 with the present application on 28 July 2003, and indicated that the certified copy of the priority document was filed in the parent case.

Accordingly, acknowledgment of the completion of all requirements under 37 CFR §1.55 is respectfully requested.

### **PENDING CLAIMS**

Claims 1-11 were pending in the application, under consideration and subject to examination at the time of the final Office Action. Unrelated to any prior art, scope

or rejection, appropriate claims have been amended, added or deleted in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, the amendments to the claims are unrelated to any prior art or scope adjustment, and are simply clarified claims in which Applicant is presently interested. At entry of this paper, Claims 1-10 remain pending in the application for consideration and examination.

#### **PROVISIONAL DOUBLE PATENTING REJECTION - IMPROPER**

In the section spanning pages 3 and 4 of the Detailed Action, Claims 1-11 are provisionally rejected under the judicially-created doctrine of non-statutory double patenting in view of Claims 1-10 of US Appl'n No. 09/764,289. However, Appl'n No. 09/764,289 matured into US 6,774,750 B1 on 10 August 2004, almost two months prior to the date of the final Office Action. Accordingly, Applicant respectfully submits that the provisional double patenting rejection is improper and should be withdrawn.

#### **POTENTIAL DOUBLE PATENTING - TRAVERSED/NOT SUPPORTED**

In the event that the improper provisional double patenting rejection is withdrawn and a rejection based on the judicially-created doctrine of non-statutory double patenting rejection is made in the next Communication regarding the present case, Applicant respectfully submits the following.

Any double patenting rejection based upon the provisional double patenting rejection in the 29 September final is respectfully **traversed**, because such rejection does not provide the factual analysis required for such rejections under U.S. patent

law, i.e., the Examiner has not satisfied his/her initial burden to adequately support the rejection. More particularly, MPEP §804 states in relevant *verbatim*:

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 USC 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 USC 103 are employed when making an obviousness-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of non-obviousness.

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Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the invention defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

The provisional rejection in the 29 September final Office Action merely states, “[t]he trip lever does not need that specific support of 09/764,289.” The provisional rejection does not make clear the differences, or the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in the claims in the patent.

Additionally, there is no indication in the 29 September final Action that any of the actual patented claims have even been reviewed, since such claims were patented prior to the date of the final Action and yet not used in a proper rejection.

Accordingly, Applicant respectfully submits that any double patenting rejection made based upon the provisional double patenting rejection in the final Office Action is traversed as unsupported without the above analysis in order for the Examiner to satisfy his/her initial burden to support the rejection.

### **REJECTIONS UNDER 35 USC §103 - TRAVERSED**

All 35 USC rejections (*i.e.*, the 35 USC §103 rejection of Claims 1-10 as being unpatentable over Rusch (US 4,222,019 A) in view of Brackett *et al.* (US 3,602,852 A); and the §103 rejection of Claim 11 as being unpatentable over Rusch in view of Kawashima *et al.* (US 5,874,877 A)) are respectfully traversed. Unrelated to any prior art, scope or rejection, Claim 11 is cancelled herein (without prejudice or disclaimer), which has rendered the rejection of such claim and traversal arguments obsolete at this point in time. Based upon the following, reconsideration and withdrawal of the remaining rejection are respectfully requested.

All descriptions of Applicants disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed.

In rejecting claims under 35 USC §103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under §103, the Examiner must produce a factual basis supported by

teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required to establish a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596 (Fed. Cir. 1988). What a reference teaches is a question of fact. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (*citing In re Beattle*, 974 F.2d 1309, 1311, 24 USPQ2d 1040, 1041 (Fed. Cir. 1992)). (*In re Baird* addresses the substitution of a claim limitation by an element that is alleged to be the same or to operate the same; “the requirements of the claim cannot be ignored or substituted.”)

However, the cited prior art does not adequately support a §103 obviousness-type rejection because it does not, at minimum, disclose (or suggest) limitations of Applicant’s claims. **More particularly, the rejections and Office Action comments appear to reflect no appreciation of Applicant features/limitations of “a disengaging device including a trip lever mounted on a yoke of said coil, and separated from said fixed frame for rotation so as to interrupt the contact between said moving contact and said fixed contact by said toggle link mechanism”.** Such are again explained as follows.

More specifically, Applicant’s invention is directed toward preventing a “mis-tripping” of circuit breakers which may occur when the circuit breaker is initially turned on. Within a circuit breaker, there is a “fixed frame” that may be used for

supporting a moving contact of the breaker. Applicant's made extensive study of mis-tripping, and found that when a disengaging (e.g., overcurrent) device including a tripping lever is also supported by the "fixed frame", mechanical shock and/or vibrations transmitted through the fixed frame may disadvantageously cause mis-tripping.

More particularly, Applicant's found that when the circuit breaker is initially turned on, the primary circuit's moving contact is actually physically slammed into the primary circuit's fixed contact causing significant mechanical shock and/or vibrations. Since the moving contact was supported on the fixed frame, the mechanical shock and/or vibrations were transmitted into the fixed frame. If the disengaging device including the tripping lever is also supported by the "fixed frame", the mechanical shock and/or vibrations were then transmitted to the tripping lever. The shock and/or vibrations may shake loose a latching of the disengaging mechanism so as to cause mis-tripping of the breaker.

In order to avoid/solve such problem, **Applicant's disclosed and claimed invention physically "separated" Applicant's disengaging device including trip lever from Applicant's "fixed frame". As one important aspect of such separation, Applicant's trip lever is "mounted on a yoke of said coil"**. Such is described on page 3, lines 3-7; and page 5, line 27 extending to page 6, line 13 of Applicants' original specification, and FIGs. 1-2, and is defined in Applicants' claims.

Since the disengaging device including the trip lever is separated from the fixed frame, **any mechanical shock and/or vibrations caused by moving-/fixed contact slamming is much less transmitted from Applicant's fixed frame to**

**Applicant's disengaging device (e.g., trip lever).** That is, the mechanical shock and/or vibrations must be transmitted from the fixed frame to the breaker's housing, then to the yoke, and finally to the trip lever. Such longer travel path, and such transitioning across several component-to-component interfaces, serve to attenuate and/or dissipate the mechanical shock and/or vibrations before such arrives at the trip lever. Less shock/vibrations of the trip lever advantageously results in less mis-tripping during breaker initializing.

Turning now to rebuttal, none of Rusch, U.S. Patent No. 4,222,019, as a primary reference, or Brackett, U.S. Patent No. 3,602,852, or Kawashima et al, U.S. Patent 5,874,877, discloses or suggests a circuit breaker in which a trip lever of a disengaging device is "mounted on a yoke of said coil" (**not** mounted on a fixed frame of the opening/closing mechanism 8 as shown in FIGs. 1-5) and "separated from a fixed frame".

More particularly, Rusch discloses (e.g., FIGS. 1-2) embodiments wherein disengaging components including trip lever components 47, 48, 49 **are not supported by Rusch's yoke 16 separate from the frame, but instead appear to all be supported on Rusch's frame**. Hence, Rusch does not disclose or suggest Applicant's features/limitations.

Likewise, Brackett discloses (e.g., FIG. 4) embodiments where disengaging components including flat 65, tooth 67, etc., **are not supported by Brackett's yoke separate from the frame, but instead appear to all be supported on Brackett's frame 31**. Hence, Brackett does not disclose or suggest Applicant's features/limitations.

Finally, Kawashima discloses (e.g., FIG. 1) embodiments where disengaging components including trip lever 24 **are not supported by Kawashima's yoke separate from the frame, but instead appear to all be supported on Brackett's case 32.** Hence, Kawashima does not disclose or suggest Applicant's features/limitations.

**Given that none of the applied references discloses/suggests Applicant's trip lever arrangement supported by a yoke, it is respectfully submitted that no combination of such references would have disclosed/suggested Applicant's claimed features/limitations.**

The following comments from Applicant's foreign representative are further submitted in traversal of the rejection.

Rusch discloses the latch structure referred to Figs. 1 and 2 in which the bimetal 64 whose an upper portion is fixed is moved in a clockwise direction by overcurrent, whereby the arm portion 49 is pressed to release a sharp edged step of a bow-shaped pawl. That is, Rusch does not disclose ones corresponding to the fixed frame and the trip lever according to the present invention, discloses the latch mechanism which is provided on a lower portion of a handle 36, and no structure of separating the trip lever from the fixed frame according to the present invention.

Brackett *et al.* discloses the circuit protector referred to Figs. 4 and 5 thereof having a frame 31 provided with a latch portion (latch teeth 67, a catch pin 60, an edge 65, 1 of a semilunar catch) and no structure of the trip lever separated from a fixed frame according to the present invention.



Kawashina *et al.* discloses the latch portion, the trip lever and the over-current tripping device divided, to three parts. In contrast, Applicant's present invention is focused on the fixed frame being separated from the trip lever. The present invention, thus has an advantage of preventing miss-trip by separating the trip lever from the fixed frame.

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support §103 obviousness-type rejections of Applicant's claims. Accordingly, reconsideration and withdrawal of such §103 rejections, and express written allowance of all of the rejected claims, are respectfully requested.

#### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

### EXAMINER INVITED TO TELEPHONE

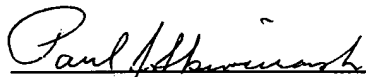
The Examiner is invited to telephone the undersigned at the local D.C. area telephone 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

This Amendment is being filed within the shortened statutory period for response set by the 18 June 2004 Office Action, and therefore, no Petition or extension fee is required. To whatever other extent is actually necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. No additional claims fees are required for entry of this paper. Please charge any actual required fee to ATS&K Deposit Account No. 01-2135 (as Case No. 501.37459X00).

Respectfully submitted,



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